

REMARKS

A. Drawing objection

The examiner has objected to the drawings because Figs. 1 and 2 depict prior art but do not include a legend indicating this. Applicants enclosed a substitute drawing sheet that identified Figs. 1 and 2 as prior art.

B. 35 U.S.C. § 112, first paragraph

The examiner has rejected claims 1, 5, 6, 8, and 9 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification. The examiner has stated that these claims include the term “an outer layer of stretched leather” but that the specification discloses only an outer layer of stretchable leather. Applicant has amended the claims to overcome this ground for claim rejection.

C. 35 U.S.C. § 103(a)

The examiner has rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over international reference WO 92/14372 (“WO ‘372”) in view of U.S. Patent No. 5,163,198 to Herber (“Herber”). The examiner contends that WO ‘372 discloses all of the limitations of the claimed invention except for the insulating material being located but not compressed between the toe box and the lining. The examiner contends that Herber teaches an insulating layer 4 for a toe protected boot located, uncompressed, between the toe box 3 and a lining 6. Applicant has canceled claim 1

WO ‘372 discloses a boot having an removable protective insert. The insert includes a fabric backed foam layer 43 and, in some embodiments, a toe cap 27. Comparison of Fig. 3 (no toe cap) with Figs. 2 and 4 (with toe caps) shows that a layer of foam having an uniform

thickness is provided over an area corresponding to the top of a user's forefoot with this layer being compressed to a smaller thickness in the regions where the toe cap is present.

Herber discloses a plastic shoe with a toe cap anchored within the molded plastic of the shoe. Herber teaches that a foam layer on the underside of the toe cap aids in the manufacture of a molded plastic shoe including a securely-anchored toe cap as well as cushioning the inside of the toe cap. [Col. 1, lines 65-68.] The layer of foam remains in an uncovered state. The lining 6 referred to be the examiner is a removable orthopedic pad overlying the shoe sole. [Fig. 1; Col. 2, lines 49-50.]

Applicant respectfully submits that the combination of WO '372 and Herber is improper. No motivation has been shown for combining the uncompressed, uncovered foam layer of Herber, which is provided to achieve manufacturability of a molded plastic shoe with a toe cap integrally anchored within the molded plastic with the fabric-backed foam-layer lining the toe cap of the removable shoe insert of WO '372. Absent such a showing, applicant respectfully requests that the claim rejections based on this combination be withdrawn.

Even if the combination of WO '372 and Herber were proper, applicant respectfully submits that claim 10 presented herein is patentable over these references.

Nothing in WO '372 teaches or suggests that the foam layer provides any cold insulating function. The foam layer of WO '372 is said to provide only a cushioning function. In addition, the compression of the foam under the toe caps of WO '372 suggests that the cold insulating properties of the boot are not of interest.

Nor does anything in Herber teach or suggest a foam layer having a cold insulating function. The foam layer of Herber provides cushioning and aids in the manufacturing of the molded plastic shoe.

Applicant also finds nothing in either WO '372 or Herber that teaches or suggests an oversized toe box, *i.e.*, a toe box sized to enclose a sufficient quantity of insulating material to provide enhanced thermal protection of a user's foot without being compressed by contact with a user's foot during use. By contrast, the cushioning function disclosed in both WO '372 and Herber suggest that contact between a user's foot and the foam is expected (because the foam is placed on the underside of a conventional, rather than an oversized, toe box). This in turn suggests that compression of the respective foam layers resulting from such contact is likely, detracting from any possible thermal protection function.

In addition, the lining 6 of Herber is, as described above, a removable orthopedic pad overlying the shoe sole. [Fig. 1; Col. 2, lines 49-50.] Nothing in Herber teaches or suggests a lining on the side of the foam layer 4 opposite the toe box 3. To the contrary, Herber teaches away from any covering on the underside of the foam layer 4 in that the foam cushion is intended to absorb air displaced from the plastic during manufacture of the shoe and thereby prevent air-bubble inclusions in the plastic. [Col. 1, lines 59-68.]

For the reasons stated above, the combination of WO '372 and Herber does not yield the claimed invention. Accordingly, applicant submits that claim 10 is allowable over the cited references.

Claims 5, 6, 8, 9, 11, and 12 are dependent on claim 10. Applicant submits that these claims also are allowable over the cited references at least for the reasons stated above with respect to claim 1.

The examiner also has rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over WO '372 in view of Herber as applied above, and further in view of what the examiner contends is applicant's admission of obviousness as to the obviousness of varying the thickness of insulating material to achieve the desired temperature holding performance. Claims 5 and 6 have been amended to depend from new claim 10.

In addition to the reasons for allowability set forth above, neither WO '372 nor Herber includes a material (foam) that is intended to provide a cold insulating function. Applicant respectfully submits that no motivation exists to increase the thickness of the foam layers disclosed in these references to achieve a desired temperature holding performance. Applicant therefore submits that claims 5 and 6 are allowable over the above-described combination of references.

The examiner also has rejected claims 1, 5, 6, 8, and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,805,419 to White ("White") or No. 4,102,062 to Adams ("Adams") in view of WO '372 and Herber. Applicants have cancelled claim 1 and have amended claims 5, 6, 8, and 9 to depend on new claim 10.

Applicants respectfully submit that the claims presented herein are allowable over each of the cited combinations of references for the reasons stated below.

White discloses a fabric-backed foam layer applied to the underside of a toe cap. As with both WO '372 and Herber, the toe cap is conventionally sized. The foam layer is compressible.

[Col. 1, line 66.] This suggests that compression of the foam layer, *e.g.*, during contact with a user's foot, is expected.

Adams discloses a metatarsal guard 13 having a layer of fabric-backed foam applied to its inner surface. The metatarsal guard 13 is adjacent to and supported at its forward lower edge by the toe protector 12. The shape of the metatarsal guard is "essentially that of the bootlast, so that its incorporation does not interfere with conventional boot forming techniques." [Col. 2, lines 48-50.]

Applicants find nothing in Adams that teaches or suggests that the toe protector 12 is oversized. Applicants also find nothing in Adams that teaches or suggests any lining for the toe protector 12.

Even if the Adams metatarsal guard could properly be construed to be a toe box, the metatarsal guard is of a conventional size. The foam layer on the underside of the metatarsal guard performs a cushioning function only; applicants find nothing in Adams that teaches or suggests that the foam has an cold insulating function. The foam layer also is separate from, rather than adhered to the metatarsal guard structure. [Col. 3, lines 2-5 "it is preferable as described that the molded plastic metatarsal guard be essentially free of surface bonding to the adjacent flexible layer or layers of rubber and fabric . . . This allows the guard to have some small freedom for temporary deformation and return to shape. "]

Neither WO '372 nor Herber teach or suggest the elements of the claimed invention absent from White and Adams. Accordingly, applicants respectfully request that the rejection of claims 5, 6, 8, and 9 be withdrawn and that allowability of claims 10-12 be indicated.

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CONCLUSION

For the reasons stated above, the claims presented herein satisfy the statutory requirements of patentability and are patentable over the cited references. Applicants respectfully submit that the claims are condition for allowance and request that a Notice of Allowance be issued.

Respectfully submitted,

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